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#### **REMARKS**

The Office Action mailed May 20, 2004, has been received and reviewed. Claims 84, 85, and 87-117 are currently pending in the application. Claims 92-96, 98-101, and 103-113 are withdrawn from consideration. Claims 84, 85, and 116 have been amended herein.

The following remarks are filed as a supplement to Applicants' response mailed January 20, 2004, which is alleged by the Examiner to be nonresponsive.

Applicants respectfully request reconsideration of the pending claims in light of the amendments and remarks presented herein.

#### Wardle '534 Reference

The Examiner states that Applicants did not respond to the correct Wardle reference and clarifies that the correct Wardle reference is United States Patent No. 5,472,534. The Examiner states that he believes this reference was cited in the PTO-1449 returned with Paper 32, and asks that a copy of this PTO-1449 be supplied with the response. For the Examiner's convenience, Applicants have included a copy of the PTO-1449 returned with Paper 32. Applicants note that no reference corresponding to United States Patent No. 5,472,534 to Wardle *et al.* is cited therein. Therefore, Applicants acknowledge the Examiner's filing of Form-892 with the Office Action of May 20, 2004, in which United States Patent No. 5,472,534 to Wardle *et al.* ("Wardle '534") is made of record.

#### /Terminal Disclaimers

The Examiner states that only one terminal disclaimer was present in the official electronic record. However, Applicants respectfully submit that three terminal disclaimers (for United States Patent Nos. 5,673,935, 6,039,820, and 6,481,746) were filed with the response filed on January 20, 2004. Copies of the three terminal disclaimers as filed are enclosed for the Examiner's convenience, as is a copy of the date-stamped postcard evidencing receipt of same by The Office.

#### 35 U.S.C. § 112 Claim Rejections

Claims 83-91, 97, 102, and 114-117 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse this rejection, as hereinafter set forth.

The Examiner states that the claims are indefinite because the language "formulated for generating gas suitable for use in deploying an air bag or balloon from a supplemental restraint system" and "gas suitable for use in deploying an air bag or balloon from a supplemental restraint system" is indefinite. Office Action of October 16, 2003, p. 3 and Office Action of May 20, 2004, p. 2. In the outstanding Office Action, the Examiner has emphasized the language "gas suitable for use." Office Action of May 20, 2004, p. 2. However, in the previous Office Action, the Examiner's rejections appeared to focus on allegedly inconsistent meanings of this language. Since it is unclear from the Examiner's statements in these two Office Actions whether the claims are rejected due to the specific language that is used or due to the allegedly inconsistent meanings of this language, Applicants address both issues herein.

To meet the requirements of 35 U.S.C. § 112, second paragraph, the scope of the claim must be clear to a hypothetical person possessing the ordinary level of skill in the pertinent art. M.P.E.P. § 2171. The definiteness of the claim language is analyzed in light of, *inter alia*, the content of the patent application. M.P.E.P. § 2173.02.

Applicants respectfully submit that a person of ordinary skill in the art would understand the scope of the claims in light of the teachings in the specification. Applicants note that the Examiner has provided no specific reason to explain why this language is considered indefinite. As explained in the specification, gas generating compositions that are used in air bags or balloons must have specific properties in order to deploy the air bags or balloons. See for example paragraphs [0004]-[0008], [0014], [0017], [0019], [0022], and [0026]. As also described in the specification, the gas generating compositions of the present invention have properties that enable them to be used to deploy an airbag or balloon. Since a person of ordinary

skill in the art would understand the scope of the claims in light of the teachings in the specification, Applicants request that the rejections be withdrawn.

The fact that the BPAI considered this claim language and did not reject it as being indefinite further supports Applicants' position that this language is definite. The BPAI is authorized to make new rejections of claims under MPEP § 1213.02 and, therefore, the BPAI could have rejected this language if it felt that the claims were indefinite. Since the BPAI did not reject the claims as being indefinite, it can be implied that the BPAI felt that this language was sufficiently definite to apprise one of ordinary skill in the art of the scope of the claims. The Examiner also states that the Appellants' argument on the meaning of this language "lacked any proper factual basis." Office Action of October 16, 2003, p. 3. However, as noted by the BPAI, the Examiner had the burden of showing that the compositions of the references relied upon in the Appeal had the claimed properties and that the Examiner had not met this burden. Decision on Appeal, p. 3-4. It is improper for the Examiner to shift this burden to the Applicants.

In regard to the alleged inconsistencies in meaning of the claim terms, the Examiner states that "in reply to a rejection in Paper No. 14, applicants stated that the noted claim terminology had a certain meaning. . . . Later, applicants stated in their Appeal Brief, that this terminology had a different meaning." In the Office Action response mailed June 15, 2000, which was submitted in response to Paper 14, Applicants stated that the solid composition of claim 1 is "prepared from ingredients selected so that the resultant composition is adapted to be combusted to generant [sic] gas for deploying an air bag or balloon from a supplemental system restraint system. The gas generant ingredients are combined such that when the composition combusts, nitrogen gas and water vapor are produced." Office Action of June 15, 2000, p. 2-3. In the Appeal Brief, Applicants stated that "[t]he composition is formulated so that, when combusted, it generates a mixture of gases suitable for use in deploying an air bag or balloon from a supplemental restraint system. Stated differently, the composition is defined by a property, i.e., suitability for a supplemental restraint system, that the composition possesses upon combustion." Appeal Brief, p. 11-12.

After reviewing Applicants' response to Paper 14 and the Appeal Brief, Applicants believe that these two statements are consistent and explain that the solid gas generating composition, when combusted, produces gases that are used to deploy the air bag or balloon.

Applicants note that the Examiner has not explained why he believes the statements in the response to Paper 14 and in the Appeal Brief are inconsistent. Furthermore, the Examiner has not identified specific portions of the response to Paper 14 and the Appeal Brief that are allegedly inconsistent. As such, the Applicants are unclear about the exact nature of the alleged inconsistencies and, therefore, it is difficult for the Applicants to effectively address the Examiner's issues. In the event that the Examiner maintains the indefiniteness rejections of the claims, Applicants respectfully requests further clarification of the alleged inconsistencies between the two statements.

The Examiner also states that the Applicants failed to respond to the indefiniteness rejection as to the term "suitable" because the Applicants did not comment on the 14 references cited by the Examiner as disclosing apparatus and/or compositions suitable for use therein.

Office Action of May 20, 2004, p. 3. Based upon Applicants' understanding of the Examiner's argument, the Examiner appears to believe that the claims are indefinite because they do not recite limitations that limit the use of the gas generating composition to a specific apparatus. The Examiner states that "the instant claims have been left broad as to the kind of apparatus. *Id.*However, the "[b]readth of a claim is not to be equated with indefiniteness." M.P.E.P. 2173.04. "If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defied in the claims, then the claims comply with 35 U.S.C. 112, second paragraph." *Id.* 

Applicants note that the specification clearly discloses properties that are exhibited by the gas generant, when combusted, in order to inflate the air bag or balloon. In addition, the specification discloses gas generating devices, such as air bags, in which the gas generating composition are used. See p. 16, line 16 through p. 17, line 2 and p. 22, line 25 through p. 26, line 22. Since a hypothetical person possessing the ordinary level of skill in the pertinent art

would understand the scope of the term "suitable" in the claims by referring to the specification, the claims are definite and the indefiniteness rejections should be withdrawn.

While Applicants realize that the claims are to be given their broadest reasonable interpretation during prosecution, the broadest reasonable interpretation must be consistent with the specification. M.P.E.P. 2173.05(a). "The meaning of every term used in a claim should be apparent from the prior art or from the specification and drawings at the time the application is filed." *Id.* (emphasis added). Since the specification discloses gas generating devices in which the gas generating composition are used, a hypothetical person possessing the ordinary level of skill in the pertinent art could ascertain the metes and bounds of the claims by referring to the specification. As such, it is improper for the Examiner to state that "applicants' failure to discuss the relevant and applied prior art for what the terms mean . . . constitutes a failure to respond."

Office Action of May 20, 2004, p. 3. In addition, since the specification discloses gas generating devices in which the compositions are used, it is unclear why the Examiner relies on the 14 references to determine the meaning of the term "suitable." Furthermore, since the specification provides sufficient disclosure for one of ordinary level of skill in the pertinent art to ascertain the metes and bounds of the claims, it is unnecessary to refer to the prior art to determine the meaning of the term.

The Examiner also states that the failure to discuss the cited references "leaves an impression of inoperability of the conventional techniques, which is impermissible." *Id.*However, contrary to the Examiner's assertions, Applicants have not characterized the cited references as inoperable for their intended purposes. Rather, Applicants have argued that the cited references are unsuitable for use as gas generants in a gas generant device, such as an airbag or balloon.

The Examiner also states that Applicants have failed to discuss the cited case law about the scope of "comprising." Applicants have amended claims 84, 85, and 116 to recite that the gas generating composition consists essentially of the recited components, rendering this rejection moot.

#### 35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 5,545,272 to Poole et al., U.S. Patent No. 5,071,630 to Oberth, U.S. Patent No. 5,531,941 to Poole, U.S. Patent No. 3,692,495 to Schneiter et al., and Further in View of Lund, Wardle '534, and U.S. Patent No. 5,731,540 to Flanigan et al.

Claims 83-87, 89-91, 102, and 114-117 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,545,272 to Poole *et al.* ("Poole '272"), U.S. Patent No. 5,071,630 to Oberth ("Oberth"), U.S. Patent No. 5,531,941 to Poole ("Poole '941"), U.S. Patent No. 3,692,495 to Schneiter *et al.* ("Schneiter"), and further in view of Lund, Wardle '534, and U.S. Patent No. 5,731,540 to Flanigan *et al.* ("Flanigan").

Claim 83 was canceled in Applicants' previous response, rendering the obviousness rejection moot as to that claim. The obviousness rejection of remaining claims 84-87, 89-91, 102, and 114-117 is improper because the cited references do not teach or suggest all the limitations of the claims and do not provide a motivation to combine.

The cited references do not teach or suggest the limitation of "at least one complex of a metal cation and at least one neutral ligand which comprises ammonia, wherein the metal cation is a transition metal cation or an alkaline earth metal cation, and sufficient anion to balance the charge of the metal cation," as recited in claim 84, or the limitation of "a complex of a metal cation and a neutral ligand containing hydrogen and nitrogen and sufficient oxidizing anion to balance the charge of the metal cation, wherein the complex is selected from the group consisting of metal nitrite ammines, metal nitrate ammines, metal perchlorate ammines, and mixtures thereof," as recited in claims 85 and 116. Nothing in the cited references teaches or suggests such a complex and, therefore, the cited references do not cure the deficiencies discussed in the previous Office Action response in the anticipation rejection under Lund.

Claims 86, 87, 89-91, 102, 114, 115, and 117 are allowable, *inter alia*, as depending from an allowable base claim.

In addition, the cited references do not provide a motivation to combine to produce the claimed invention because nothing in the cited references suggests using the complex recited in

claims 84, 85, and 116. The Examiner states that it would have been obvious of one of ordinary skill in the art to substitute common physical agents, such as release agents, and to vary amounts of notoriously well known ingredients to produce the claimed invention. Office Action of October 16, 2003, p.8. However, even if the cited references were combined, the claimed invention would not be produced because the limitations discussed above would be lacking.

Since the cited references do not teach or suggest all the limitations of claims 84-87, 89-91, 102, and 114-117 and do not provide a motivation to combine, Applicants respectfully request that the obviousness rejection be withdrawn.

#### **ENTRY OF AMENDMENTS**

The amendments to claims 84, 85, and 116 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

#### **CONCLUSION**

Claims 84, 85, 87-91, 97, 102, and 114-117 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,

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Date: June 17, 2004 KAH/JAW/ps:ljb Document in ProLaw



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## TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A PRIOR PATENT

Docket Number (Optional) 2507-5818.1US (21494-US-09)

In re Application of: Hinshaw et al. Application No.: 09/025,345

Filed: February 18, 1998

For: METAL COMPLEXES FOR USE AS GAS GENERANTS

The owner\*, Alliant Techsystems Inc. of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 5,673,935. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. The undersigned is an attorney of record.

1/16/04

Signature

Date

Joseph A. Walkowski

Typed or printed name Reg. No. 28,765

Terminal disclaimer fee under 37 CFR 1.20(d) is included.

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Transmittal Form (1 page w/duplicate copy); Amendment in response to office action dated October 16, 2003 (18 pages); Terminal Disclaimer to Obviate a Double Patenting Rejection Over a Prior Patent; Check no. 5629 in the amount of \$110.00; Terminal Disclaimer to Obviate a Double Patenting Rejection Over a Prior Patent; Check no. 5628 in the amount of \$110.00; Terminal Disclaimer to Obviate a Double Patenting Rejection Over a Prior Patent; Check no. 5630 in the amount of \$110.00; Supplemental Information Disclosure Statement (4 pages); Form PTO-1449 (3 pages); Check no. 5627 in the amount of \$180.00; copies of cited references.

Invention:

METAL COMPLEXES FOR USE AS GAS

**GENERANTS** 

Applicant(s):

Hinshaw et al.

Filing Date: Serial No.: February 18, 1998 09/025,345

Date Sent:

January 16, 2004 via first class mail

Docket No.: JAW/ljb

2507-5818.1US





#### United States Patent and Trademark Office

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ATTORNEY DOCKET NO.

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**Commissioner of Patents and Trademarks** 

This is responsive to Paper No. 32. Note attachments, Form 1449, Papers No. 3, 4, and 4 1/2. The application is being returned to the Honorable Board of Patent Appeals and Interferences for decision.

EDWARD A. MILLER PRIMARY EXAMINED

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